

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention is directed to an apparatus and method for distributing information or services through a computer or cellular network. A piece of information or service to be distributed through the network is composed, and a list of intended recipients is compiled (steps 301, 301', 302, 601, 602). A preliminary order for crediting accounts associated with the intended recipients is transmitted through the network. The piece of information or service is released so that the piece of information or service becomes accessible to the recipients appearing on the list (steps 304, 304', 603). As a response to an indication (steps 305, 401, 606) of a certain recipient having accessed (step 605) the piece of information or service, an account associated with said certain recipient is credited (306, 608).

Independent method claim 1 is directed to "distributing information or services through a computer or cellular network," and recites the steps of "composing a piece of information r service to be distributed" (Specification page 6, lines 24-27; Fig 3a, step 301), "compiling a list of intended recipients" (Specification, page 6 line 23 bridging page 7, line 7; Fig 3a, step 301, 302), "transmitting . . . a preliminary order for crediting accounts" (Specification, page 7, lines 28-35; Fig 3a, step 303), "releasing said piece of information" (Specification, page 7, lines 28-35; Fig 3a, step 304), and "as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient," (Specification, page 8, lines 3-95; Fig 3a, step 305, 306).

Independent method claim 7 includes a composing a piece of information step (Specification page 6, lines 24-27; page 12, lines 32-34; Fig 3a, step 301; Fig. 6, step 601), a compiling a list of intended recipients step (Specification, page 6 line 23 bridging page 7, line 7; page 13, lines 3-5; Fig 3a, step 301, 302; Fig. 6, step 602), a releasing said piece of information step (Specification, page 7, lines 28-35; page 13, lines 12-15; Fig 3a, step 304; Fig. 6, step 604), and a step in response to an indication (Specification, page 8, lines 3-95; page 13, lines 23-32; Fig 3a, step 305, 306; Fig. 6, step 606). Further, independent method claim 7 also includes the substeps of "defining the time taken for said indication to be received; and crediting said account by an amount

which is inversely proportional to said time” (Specification, page 14, lines 13-29; Fig 6, step 607, 608). Independent method claim 13 recites subject matter similar to independent claims 1 and 7, and further recites the substeps of “ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and crediting said account associated with said certain recipient bases on the order ranking” (Specification page 14, lines 19-29; Fig. 6, step 606, 607).

Independent apparatus claims is directed to an arrangement for distributing information or services through a network, and includes “a source of information or services” (Specification page 5, lines 8-10; Fig. 1, item 101), a number of subscriber terminals” (Specification page 15, lines 15-28; Fig. 8, item 801), a “means for maintaining accounts” (Specification page 15, line 30, bridging to page 16, line 13; Fig. 9, item 901; Fig. 10, item 1001), a “means for transmitting to the means for maintaining accounts” (Specification page 14, lines 34-35; page 15, lines 16-20; page 15, lines 30-31; Fig. 7, item 703; Fig. 8, item 803; Fig. 9, item 902), a “means for providing an indication” (Specification page 15, lines 18-28; Fig. 8, item 806), and a “means for responding to said indication” (Specification page 15, lines 5-10; Fig. 7, item 709; Fig. 10, item 1004).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 1, 8, 9, 11, and 12 can properly be rejected as indefinite under 35 U.S.C. § 112, second paragraph.

2) Whether Goldhaber discloses each and every element of claims 1-6 and 8-10, as required under 35 U.S.C. § 102(b).

3) Whether claims 7 and 13 can properly be rejected as obvious under 35 U.S.C. § 103(a) based on the combination of Goldhaber and the Examiner's statement of what was known in the art at the time of the invention.

VII. ARGUMENT

Grounds of Rejection No. 1

Claims 1 and 11 recite a “a preliminary order for crediting accounts associated with the intended recipients.” Claims 8, 9 and 12 each recite “a preliminary order for crediting the accounts associated with the certain subscribers.” The Examiner contends that the disclosure of the “. . . preliminary order for crediting the accounts . . .,” does not provide details. Based on this perceived lack of disclosure within the written description, the Examiner states that “[f]or examination purposes, the Examiner will interpret the phrase . . . [to mean] a maximum amount or a fixed amount that a provider is willing to compensate those customers that access the information.” (December 15, 2005 Detailed Action, page 3.)

Appellant respectfully disagrees with the Examiner’s position. The specification clearly explains that “[t]he preliminary nature of the order means that the actual crediting is not yet accomplished, because there is no evidence about the intended recipients actually receiving the information or service to be transmitted.” (Specification, page 7, lines 30-34.) Once there is evidence that the intended recipients have actually received the information or service to be transmitted, then the crediting will occur. Further, the Specification discloses other embodiments of the present invention and discusses the preliminary order, e.g., page 9, lines 20-35.

Because there is clear disclosure within the specification for the claim language of a “preliminary order for crediting the accounts . . .,” there is no basis for the Examiner to interpret the phrase to mean a maximum or fixed amount. The Examiner’s interpretation of this claim language does not comport with the unequivocal definition provided by the above-cited portion of the specification. Indeed, in contrast to the Examiner’s interpretation of “a maximum amount or a fixed amount” the specification clearly states that “the actual crediting is not yet accomplished.” Accordingly, Appellant submits that the written description does particularly point out the claimed subject matter.

Most importantly, the basis for the objection is without merit. The cited portions of the specification clearly provide sufficient details of the “preliminary order” to support the claim language. Therefore, the Board should overrule the Examiner as to this objection to claims 1 and 11.

Grounds of Rejection No. 2

Appellant submits that Goldhaber is directed to a system which, as shown in Fig. 2 is directed to a “positively priced information” system in which a consumer pays for information, e.g., a television program. As shown in Fig. 3, Goldhaber is directed to a “negatively priced information” system in which a consumer is paid for paying attention to information, e.g., an advertisement. In both systems the request for payment or the offer for payment is sent to the consumer who can act on it. If acted on, information debiting the customer’s account or crediting it is sent to an accounting system. Consumers may be located for targeted approaches by reference to a data base of digitally stored demographic profiles of potential users. Information can be routed to users based on demographics.

According to the present invention, as claimed, when the consumer is targeted to receive information, and the sender is willing to compensate the consumer for paying attention to it, the present invention transmits to the accounting system “through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients. Thus, in the Goldhaber system the sender of the information could promise to pay and then not pay. In the present system, since a preliminary credit has already been sent to the accounting system, as soon as the user views the information “a response to an indication of a certain recipient having accessed said piece of information or service” is generated and causes the accounting service to credit “an account associated with said certain recipient.” Goldhaber does not teach, nor suggest, transmitting “a preliminary order for crediting accounts” associated with the intended recipients, as required by the claims 1-6 and 8-12.

The Examiner relies on Goldhaber, Fig. 2 and the related text as disclosing “transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients.” (December 15, 2005 Detailed Action, page 4.) Appellant submits that Goldhaber Fig. 2 and its related text, (*see* col. 10, lines 8-38), discloses that a consumer requests information, the consumer is asked to compensate the provider for the information, the consumer pays for the information, and the provider provides the information. This section of Goldhaber has nothing to do with transmitting a preliminary order for crediting accounts, as required by the claimed invention. In fact this is the “positive priced information system.” As noted above, even in the negative priced information system of Fig. 3, the preliminary order is not used by Goldhaber.

Further, the Examiner contends that the Appellant has relied on features not present in the claims. (*See*, December 15, 2005 Detailed Action, page 9.) However, in the previous Response, Appellant merely asserted that one of the advantages of the “preliminary” feature is that by transmitting a preliminary crediting order before transmitting the information or service to the subscriber terminals, there is a reduction in the service provider's chance for cheating, i.e., the accounting system already has the credit information and will act on it in response to the indication of access. This assertion of advantage should not distract the Examiner from the fact that the “preliminary” feature recited in the claims is distinguishable over the Goldhaber reference itself.

Claims 2-6 and 11 depend from claim 1. Claims 9-10 and 12 depend from claim 8. These dependent claims are patentable over Goldhaber for at least the same reasons as their respective base claims. Therefore, for the reasons stated above, Appellant respectfully submits that Goldhaber does not disclose each and every feature of claims 1-6 and 8-12,

Grounds of Rejection No. 3

Independent claim 7 is directed to a method for distributing information or services through a computer or a cellular network, and recites the step of crediting an account, which includes certain recited substeps. The Examiner acknowledges that Goldhaber fails to disclose “that crediting an account associated with said certain recipient comprises the substeps of defining the time it has

taken for said indication to be received and crediting said account by an amount which is inversely proportional to said time.” (December 15, 2005 Detailed Action, page 7.) However, the Examiner contends that Goldhaber discloses the use of time-sensitive incentives such as coupons and relies on the Examiner’s own personal knowledge that it would have been obvious “to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber’s response time.” (Emphasis added.)

Appellant submits that Goldhaber’s disclosure of coupons does not make obvious the claimed feature of “crediting said account by an amount which is inversely proportional to said time,” where the time is “the time taken for said indication to be received.” Goldhaber neither discloses, nor suggests, that its coupons are time-sensitive. And even assuming that Goldhaber were to suggest that the coupons were time-sensitive, such coupons typically have full value until their expiration date, after which they have no value, a step function. Thus they do not decrease in value with time. They either have value or not. As a result, it would not have been obvious to one of ordinary skill to arrive at assigning value to the coupon which is inversely proportional to the time taken to receive an indication that a recipient accessed a piece of information, a declining ramp function.

Appellant submits that the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, citing *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).) Further, the Examiner’s example does not work in the same way as the claimed invention.

Additionally, the Examiner’s statement of what was known in the art at the time of the invention is not supported by any “concrete evidence in the record” (See MPEP § 2144.04(c), citing *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).) Accordingly in the previous response, Appellant requested that the Examiner support this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). In the Advisory Action mailed June 7, 2006, the Examiner seems to be addressing his obligation under the rules by once again asserting

Additionally, in formulating the rejection of claim 7 in the December 15, 2005 Final Office Action, the Examiner has again used vague language, (i.e., “to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber’s response time”). Such a statement with its vague language (i.e., “perhaps”) could hardly be interpreted as asserting facts “capable of instant and unquestionable demonstration as being well known.” There has certainly been no demonstration that the Examiner’s assertion is “unquestionable.” There is just as much chance that old information will be more valuable as it will be less valuable. Old movies and other collectables clearly increase in value with time.

Independent claim 13 is directed to a method of distributing information or services through a computer or cellular network, and recites the steps “crediting an account associated with said certain recipient, wherein the step of crediting an account comprises the substeps of ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and crediting said account associated with said certain recipient based on the order ranking”

The Examiner acknowledges that “Goldhaber *does not* specifically disclose crediting an account by (a) ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and (b) crediting said account associated with said certain recipient based on the order ranking.” (Detailed Action, page 8. (Emphasis in original.))

The Examiner unequivocally admits that Goldhaber does not teach these features of claim 13. In an attempt to make up for Goldhaber’s deficiencies, the Examiner argues that it is well known to reward early responders, and that this is admitted prior art. From this position, the Examiner argues that the features of claim 13 would have been obvious.

As discussed above, Appellant again submits that there has been no admission that anything is prior art. Moreover, even if it were known to reward early responders, it still would have not been obvious to rank the order of responses of recipients, and credit accounts based on the ranking. Simply knowing to reward early responders, e.g., to provide a discount for those who register before

a certain date, would result in rewarding responders based on a point in time. It would not suggest that responders be ranked individually by the time when they respond, so that even early responders are ranked according to how early they are. Thus, claim 13 is patentable over Goldhaber for at least these reasons.

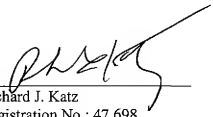
In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Frütz*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (emphasis added). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Appellant's disclosure.” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As demonstrated above, Appellants submit that the Examiner has not shown any objective teaching from the cited art that would lead an individual at the time of the invention to modify Goldhaber as done by the Examiner. A person of ordinary skill in the art in possession of Goldhaber at the time of the invention would not be motivated to modify Goldhaber's coupons to be valued on an inverse time-variant basis or a ranking of responses. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

For all of the reasons set forth above, the rejections of claims 1-13 should be reversed. Appellant respectfully requests that the application be remanded to the Primary Examiner with an instruction to withdraw the rejections, and pass the case to allowance.

Respectfully submitted,

Dated: February 20, 2007

By 
Richard J. Katz
Registration No.: 47,698

DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Appellant

APPENDIXES

4. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substep of indicating to at least part of the recipients appearing on said list that accessing said piece of information or service will cause a certain account associated with said certain recipient to be credited.
5. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substep of transmitting said piece of information or service to a number of subscriber terminals in the computer or cellular network.
6. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substeps of:
storing said piece of information or service to a place which is accessible for subscriber terminals through the computer or cellular network; and
transmitting to a number of subscriber terminals an indication of said piece of information or service being available at said place.
7. A method for distributing information or services through a computer or cellular network, comprising the steps of:
composing a piece of information or service to be distributed through the computer or cellular network;
compiling a list of intended recipients;
releasing said piece of information or service so that said piece of information or service becomes accessible to the recipients appearing on said list; and
as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient, wherein the step of crediting an account comprises the substeps of:
defining the time taken for said indication to be received; and

10. The arrangement according to claim 9, further comprising a service or information server which is arranged to store pieces of information or services in a form accessible to subscriber terminals.
11. The method according to claim 1, wherein the preliminary order for crediting accounts associated with the intended recipients includes said piece of information or service.
12. The arrangement according to claim 8, wherein the preliminary order for crediting the accounts associated with the certain subscribers includes said piece of information or service.
13. A method for distributing information or services through a computer or cellular network, comprising the steps of:
composing a piece of information or service to be distributed through the computer or cellular network;
compiling a list of intended recipients;
releasing said piece of information or service so that said piece of information or service becomes accessible to the recipients appearing on said list; and
as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient, wherein the step of crediting an account comprises the substeps of:
 ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and
 crediting said account associated with said certain recipient based on the order ranking.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings for this matter.